

REMARKS

Claims 1-4, 7-8, 10-11 and 14-15 are rejected under 35 U.S.C. §102(e) as being anticipated by *Himmel et al.* (U.S. Patent 6,324,566). Applicants traverse this rejection on the grounds that this reference is defective in supporting a rejection under 35 U.S.C. §102.

Independent Claim 1 includes:

A method comprising:

providing a first computer system with associated user access, the first computer system including bookmarks;

providing a second computer system including a search engine;

providing a remote computer system with associated user access, each of the computer systems being interconnected via a communications network;

a user selecting an indicator to cause the search engine to search websites associated with the bookmarks;

a user inputting a search term into the remote computer system that specifies that websites associated with the bookmarks are to be searched;

the search engine receiving the search term and accessing the bookmarks to obtain identifiers for the websites associated with the bookmarks and providing search results to the remote computer system;

providing a user interface of a web browser to allow users to access the search engine, the web browser to be run on either of the first and the remote computer systems for:

inputting a search term to cause the search engine to perform a search using the search term;

making a selection to cause websites associated with the user's bookmarks to be searched; and

making a selection to cause websites associated with bookmarks
stored on the remote computer system to be searched; and
the remote computer system displaying the search results.

The PTO provides in MPEP §2131..."To anticipate a claim, the reference must teach every element of the claim...". Therefore, to sustain this rejection *Himmel* must contain all of the claimed elements of independent claim 1. However, the claimed invention is not shown or taught in *Himmel*. Therefore, the rejection is unsupported by the art and should be withdrawn.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)." "The identical invention must be shown in as complete detail as contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Furthermore, Applicants traverse this rejection on the grounds that the reference is defective in establishing a *prima facie* case of obviousness for the reasons stated above.

As the PTO recognizes in MPEP § 2142:

... The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness...

The Federal Circuit has held that a reference did not render the claimed combination *prima facie* obvious in *In re Fine*, 873 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), because inter alia, the examiner ignored a material, claimed, temperature

limitation which was absent from the reference. In variant form, the Federal Circuit held in *In re Evanega*, 829 F.2d 1110, 4 USPQ2d 1249 (Fed. Cir. 1987), that there was want of *prima facie* obviousness in that:

The mere absence [from the reference] of an explicit requirement [of the claim] cannot reasonably be construed as an affirmative statement that [the requirement is in the reference].

In *Jones v. Hardy*, 727 F.2d 1524, 220 USPQ 1021 (Fed. Cir. 1984), the Federal Circuit reversed a district court holding of invalidity of patents and held that:

The “difference” may have seemed slight (as has often been the case with some of history’s great inventions, e.g., the telephone) but it may also have been the key to success and advancement in the art resulting from the invention. Further, it is irrelevant in determining obviousness that all or all other aspects of the claim may have been well known in the art.

The Federal Circuit has also continually cautioned against myopic focus on the obviousness of the difference between the claimed invention and the prior art rather than on the obviousness *vel non* of the claimed invention as a whole relative to the prior art as §103 requires. See, e.g., *Hybritech Inc. v. Monoclonal Antibodies, Inc.* 802 F.2d 1367, 1383, 231 USPQ 81, 93 (Fed. Cir. 1986).

In the present case, the reference fails to teach all the limitations of the claimed invention. Thus, the rejection is improper because, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. In this context, 35 USC §103 provides that:

A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the *subject matter* as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)

Because all the limitations of claims 1 and 8 have not been met by the *Himmei et al.* patent, it is impossible to render the subject matter as a whole obvious. Thus the explicit terms of the statute have not been met and the examiner has not borne the initial burden of factually supporting any *prima facie* conclusion of obviousness.

Therefore, independent claim 1 and the claims dependent therefrom are submitted to be allowable.

In view of the above, it is respectfully submitted that claims 1-3 and 23-27 are in condition for allowance. Accordingly, an early Notice of Allowance is courteously solicited.

Respectfully submitted,



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